REMARKS

This application was originally filed on December 21, 1999 with ten claims, three of which were written in independent form. No claims have been allowed.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,486,878 to Negishi et al. (Negishi). The applicant respectfully disagrees and submits the Examiner has failed to present a prima facie case of obviousness under 35 U.S.C. § 103.

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.

The Examiner has the duty to present a prima facie obviousness rejection. The Examiner has not pointed to any teaching in Negishi that suggests a "color modulator comprised of a stack of at least two dielectric layers and at least three transparent electrodes" as recited by Claim 1. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 2-6 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. For the reasons argued above with respect to Claim 1, the Negishi fails to show, teach, or suggest the limitations of Claim 1, much less the limitations of Claim 1 in combination with the additional limitations of Claims 2-6.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,486,878 to Negishi et al. (Negishi). The applicant respectfully disagrees and submits the Examiner has failed to present a prima facie case of obviousness under 35 U.S.C. § 103.

The Examiner has not pointed to any teaching in Negishi that suggests "voltages applied to said electrodes are operable to filter an incident white light beam into a light beam of one of three primary colors" as recited by Claim 7. The passage of Negishi cited by the Examiner only suggests selecting either a red beam or a blue beam. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 8 and 9 depend from Claim 7 and should be deemed allowable for that reason and on their own merits. For the reasons argued above with respect to Claim 7, the Negishi fails to show, teach, or suggest the limitations of Claim 7, much less the limitations of Claim 7 in combination with the additional limitations of Claims 8 and 9.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,486,878 to Negishi et al. (Negishi). The applicant respectfully disagrees and submits the Examiner has failed to present a prima facie case of obviousness under 35 U.S.C. § 103.

The Examiner has not pointed to any teaching in Negishi that suggests "altering electrical signals biasing said stack of dielectric layers such that said primary color beam of light alternates between three primary colors" as recited by Claim 10. The passage of Negishi cited by the Examiner only suggests selecting either a red beam or a blue beam. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application, Claims 1-10, accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that Claims 1-10 are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,

Charles A. Brill
Reg. No. 37,786

Texas Instruments Incorporated
PO Box 655474 M/S 3999
Dallas, TX 75265
(972) 917-4379
FAX: (972) 917-4418

Version With Markings To Show Changes Made

In the claims:

Claim 10 has been amended as follows:

10. (amended) A method of creating a full-color image, the method comprising the steps of:

providing a beam of white light;

filtering said beam of white light to produce a primary color beam of light, said filtering step performed by passing said beam of white light through a stack of at least two dielectric layers, at least one of said dielectric layers exposed to an electric field[.];

selectively modulating portions of said primary color beam of light to produce an image-bearing beam of light; and

focusing said image-bearing beam of light on an image plane; and

altering electrical signals biasing said stack of dielectric layers such that said primary color beam of light alternates between three primary colors.